

PATENT

Atty. Dkt. No. WEAT/0023.C2

REMARKS

This is intended as a full and complete response to the Notice of Non-Compliant Amendment dated December 20, 2005, having a shortened statutory period for response set to expire on January 20, 2006. Please reconsider the claims pending in the application for reasons discussed below.

Claims 21-33 remain pending in the application and are shown above. Claims 1-20 have been cancelled by Applicants. Claims 21-30, 32, and 33 are rejected and claims 31 is indicated to be allowable by the Examiner. Reconsideration of the rejected claims is requested for reasons presented below.

IDS

Second Supplemental IDS and PTO-1449 filed November 12, 2004 and received November 15, 2004 has not been considered by Examiner. Consideration of the IDS is requested.

Double Patenting

Claims 21-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 49 and 12 of U.S. Patent No. 6,425, 444. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer.

Attached is a terminal disclaimer. Applicants therefore respectfully request removal of the rejection and allowance of claims 21-23.

Claim Rejections Under 35 U.S.C. § 102

Claims 21-24 are rejected under 35 U.S.C. § 102(e) as being anticipated by *Cook, et al.* 2004/0045616.

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Regarding claim 21, the Examiner states that the tubular member is deformed in a manner such that the tubular member assumes the shape of a non-uniform surrounding surface. Applicants respectfully traverse this rejection. *Cook, et al.* discloses a tubular liner for wellbore casing, wherein the end portion 260 of the tubular member 210 "will preferably contact the interior surface 410 of the end portion 270 of the casing 115 to form a fluid tight overlapping joint." (Paragraph [0080]). As is shown in Figures 2-6 the casing 115 is of a uniform circular configuration. Therefore *Cook, et al.* does not teach, show or suggest deforming the tubular member in a manner whereby an outer surface of the tubular member assumes a shape of a non-uniform surrounding surface and forms a seal therebetween as disclosed in claim 21 and claims 22-24 and 34 which depend therefrom. Thus, Applicants submit that claims 21-24 and 34 are in condition for allowance.

Claims 25-30, 32, and 33 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Fisk, et al.* RE. 35,271.

The Examiner states that "*Fisk, et al.* discloses a method of forming a profile in tubing located in a well. The expanding device 60 is radially extendable." Applicants respectfully traverse this rejection. *Fisk, et al.* discloses a pipe bursting and replacement apparatus wherein a splitter 60 as shown in Figure 9 and 11 rests in an opening 62. The splitter 60 is a fixed diameter and is arranged not extendable from the opening 62. Due to its fixed diameter the splitter 60 begins splitting the pipe upon entry into the pipe bore. Therefore, *Fisk, et al.* does not teach, show or suggest at least one radially *extendable* expander member positioning the expander device in the wellbore at a predetermined location in the section of tubing and extending the member to deform the tubing at said location to create the profile in the internal face of the tubing as disclosed in claim 25 and claims 26-33 which depend therefrom. Thus, Applicants submit that claims 25-33 are in condition for allowance.

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Claim Rejections Under 35 U.S.C. § 103

Claims 25-30, 32, and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Wright* 1,339,641 in view of *Fisk, et al.* (applied above).

Regarding claim 25, the Examiner states it would have been considered obvious to form a profile with the device of *Wright* as taught by *Fisk et al.* since the devices operate in the same manner and it is believed that *Wright* inherently forms a profile prior to cutting. Applicants respectfully traverse this rejection.

In order to establish a prima facie case of obviousness based on the prior art, the Examiner must show some "objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *Id.* at 1783-84. Moreover, "it is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *Id.* at 1784.

Fisk et al. discloses a pipe bursting and replacement apparatus to be used for "an effective manner of removal of steel gaslines extending under paved roads and streets, particularly 4" diameter natural gas mains, and replacing of the gasline with plastic piping." (Col. 1, ln. 24-28). *Fisk et al.* does not disclose or even suggest using the pipe burster in a wellbore. The apparatus in *Fisk et al.* if used in a wellbore on casing would cut the entire casing string as it lowers into the earth. Thus, someone looking to form a profile at a predetermined location would not look to *Fisk et al.* Further, one looking to cut casing with the tool in *Wright* would not look to *Fisk et al.* for the same reason. Therefore, *Wright* in view of *Fisk et al.* does not teach, show, or suggest extending the member to deform the tubing at said location to create the profile in the internal face of the tubing as disclosed in claim 25 and claims 26-33 which depend therefrom. Thus, Applicants submit that claims 25-33 are in condition for allowance.

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Allowable Subject Matter

Claim 31 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As discussed above Applicants submit that claim 25 is in condition for allowance and thus claim 31 is also in condition for allowance.

Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed. In conclusion, the references cited by the Examiner, alone or in combination, do not teach, show, or suggest the invention as claimed.

Respectfully submitted,



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